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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,019	01/12/2005	Ayumi Asai	SHM-102-PCT	9497

7590 05/17/2006

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EXAMINER	
MOORE, MARGARET G	
ART UNIT	**PAPER NUMBER**
1712	

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/521,019	ASAI ET AL.	
	Examiner	Art Unit	
	Margaret G. Moore	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 to 10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 to 10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1 to 4, 6 to 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brieva et al. in view of Gee et al.

First please note that Brieva et al. incorporates the teachings of Gee et al. by reference (column 5, line 64, column 6, line 3).

Brieva et al. teach an oil in water emulsion that contains a surface treated pigment. The surface treatment renders it hydrophobic. See column 1, lines 20 to 24 and column 3, lines 20 to 25. This meets the oil in water requirement of claim 1 as well as component (a). This also meets claim 6.

The bottom of column 5 teaches various polyether silicone copolymers that can be used in the composition. With respect to the copolymer taught in Gee et al., please see Example 1. The copolymer prepared in this example falls within the breadth of (b). That is, a molecular weight of approx. 30,000 will correspond to approx. 400 dimethyl-siloxane units (m in claimed component (b)). This has an "n" value of approx. 4, having all methyl "R" groups.

From this the skilled artisan would have found the selection of a polyether modified silicone meeting (b) in claim 1 to the composition of Brieva et al. which contains the surface treated pigment to have been obvious.

Column 7, lines 5 and on, teaches the addition of claimed component (c). Both xanthan gum and cationic cellulosic resins are water soluble polymers.

Thus Brieva et al. teach an oil in water composition that must contain (a) and teaches the addition of (c). From a selection of polyether modified silicones one having ordinary skill in the art would have been motivated to select one meeting claimed component (b), and as such the instant claims are rendered obvious.

Also, note Example 2. This teaches a composition that differs from that claimed only in the selection of the polyether silicone. Since patentees indicate that any of the disclosed polyether silicones can be used in a comparable or equivalent manner, the skilled artisan would have been motivated to use a polyether silicone within the breadth of Gee et al. in such a composition with a reasonable expectation of success. In this manner also the instant claims are rendered obvious.

Note that Example 2 contains an additional silicone oil meeting claim 2. Note too that each component in this example is present in amounts meeting claims 7 and 8. For claim 9, see column 4, line 10. This composition is used as a cosmetic, meeting claim 10.

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brieva et al. in view of Gee et al. as applied to claim 1 above, and further in view of Date et al. or Muller et al.

While Brieva et al. teach the addition of cosmetically acceptable thickeners, they do not teach the specific compounds found in claim 5.

As can be seen from the teachings starting on column 8 line 47 and on, the thickeners used in Brieva et al. are known to be functionally equivalent with the polymers found in claim 5. (Note that gelling agent and thickening agent are terms that are used interchangeably in the art.) Muller et al. provide a similar teaching on column 18, starting on line 15.

In view of the fact that water soluble polymers such as carboxyvinyl or an acrylic acid copolymer are known to function in an equivalent manner to the thickeners taught by Brieva et al., one having ordinary skill in the art would have been motivated to replace one known thickener with another. It is prima facie obvious to substitute equivalents, motivated by the reasonable expectation that the respective species will behave in a comparable manner or give comparable results in comparable circumstances. The express suggestion to substitute one equivalent for another need not be present to render the substitution obvious.

4. The remaining references are cited as being of general interest. Harashima teaches a silicone gel containing (a) and (b) but this does not appear to be an oil in water composition, nor does it teach or suggest the addition of (c). Hoeffkes et al. teaches an oil in water composition but fails to adequately suggest the specific polymer (b).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
5/12/06